

3

| | | | |
|-------------------------------|------------------------|---------------------|--|
| Notice of Allowability | Application No. | Applicant(s) | |
| | 09/840,861 | DUPRET ET AL. | |
| | Examiner | Art Unit | |
| | Young J. Kim | 1637 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the After-Final Amendment received on July 20, 2005.
2. ☒ The allowed claim(s) is/are 1,50-80 and 82-93.
3. ☒ The drawings filed on 25 April 2001 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| <ol style="list-style-type: none"> 1. <input type="checkbox"/> Notice of References Cited (PTO-892) 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____ 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | <ol style="list-style-type: none"> 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6. <input type="checkbox"/> Interview Summary (PTO-413), Paper No./Mail Date _____ 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance 9. <input type="checkbox"/> Other _____ |
|---|---|

S.O.D

Examiner Comment

The Crameri et al. rejection (U.S. Patent No. 6,376,246 B1, issued April 23, 2002, filed September 28, 1999, priority February 5, 1999) under 35 U.S.C. 102(e), made Final in the Office Action mailed on April 20, 2005 is withdrawn in view of the certified translation of the foreign application – FR 98/10338, filed on August 12, 1998 – received on July 20, 2005, thereby antedating Crameri et al. reference.

The Crameri et al. rejection (U.S. Patent No. 6,376,246 B1, issued April 23, 2002, filed September 28, 1999, priority February 5, 1999) in view Stemmer et al. (U.S. Patent No. 5,830,721, issued November 3, 1998, 102(e) date March 4, 1996), under 35 U.S.C. 103(a), made Final in the Office Action mailed on April 20, 2005 is withdrawn in view of the fact that the primary reference, Crameri et al. reference fails as a prior art reference as reasons set forth above.

The Pachuk et al. (U.S. Patent No. 6,143,527, issued November 7, 2000, filed May 6, 1997, priority May 6, 1996) rejection under 35 U.S.C. 102(e), made Final in the Office Action mailed on April 20, 2005 is withdrawn in view the cancellation said claim in the Amendment received on July 20, 2005.

Reasons for Allowance

While Pachuk et al. (U.S. Patent No. 6,143,527, issued November 7, 2000, filed May 6, 1997, priority May 6, 1996) disclose a method of recombination via use of hybridizing two oligonucleotide fragments adjacent to each other, followed by their ligation, the recombination is not random in that the two fragments being recombined as done so as to achieve selected

Art Unit: 1637


characteristics. Nowhere in Pachuk et al. reference, do the artisans teach or reasonably motivate an ordinarily skilled artisan to achieve random recombination by the claimed method steps.

Inquiries


Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Young J. Kim whose telephone number is (571) 272-0785. The Examiner is on flex-time schedule and can best be reached from 8:30 a.m. to 4:30 p.m. The Examiner can also be reached via e-mail to Young.Kim@uspto.gov. However, the office cannot guarantee security through the e-mail system nor should official papers be transmitted through this route.

If attempts to reach the Examiner by telephone are unsuccessful, the Primary Examiner in charge of the prosecution, Dr. Kenneth Horlick, can be reached at (571) 272-0784. If the attempts to reach the above Examiners are unsuccessful, the Examiner's supervisor, Dr. Gary Benzion, can be reached at (571) 272-0782.

Papers related to this application may be submitted to Art Unit 1637 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant does submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office. All official documents must be sent to the Official Tech Center Fax number: (571) 273-8300. For Unofficial documents, faxes can be sent directly to the Examiner at (571) 273-0785. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.


Young J. Kim
Patent Examiner

**YOUNG J. KIM
PATENT EXAMINER**


KENNETH R. HORLICK, PH.D
PRIMARY EXAMINER

8/30/05

Application/Control Number: 09/840,861

Page 4

Art Unit: 1637

Art Unit 1637

8/29/2005

yjk

A handwritten signature in black ink, consisting of several loops and a long horizontal stroke extending to the right.